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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/760,979	01/20/2004	Matthias Konrad	03/009 MFE	3482

38263 7590 11/14/2005

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EXAMINER

CHEN, VIVIAN

ART UNIT	PAPER NUMBER
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1773

DATE MAILED: 11/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/760,979

Applicant(s)

KONRAD ET AL.

Examiner

Vivian Chen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 August 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15, 17-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 and 17-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Terminal Disclaimer

1. The terminal disclaimer filed on 8/11/2005 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of any patent issuing from Application No. 10/765,242 has been reviewed and is accepted. The terminal disclaimer has been recorded.

Claim Rejections - 35 USC § 112

2. Claim 7 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 7, the use of the language "comprising" is inconsistent with independent claim 1.

Double Patenting

3. The rejections under the judicially created doctrine of obviousness-type double patenting has been withdrawn in view of the Terminal Disclaimer filed 8/11/2005.

Claim Rejections - 35 USC § 103

4. Claims 1-15, 17-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over:

(a) PEIFFER ET AL (US 2002/0071945); or

(b) PEIFFER ET AL (US 2002/0068158); or

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(c) PEIFFER ET AL (US 2002/0068159); or

(d) EUROPEAN PATENT APPLICATION 1 197 328 (EP '328); or

(e) EUROPEAN PATENT APPLICATION 1 197 327 (EP '327); or

(f) EUROPEAN PATENT APPLICATION 1 197 326 (EP '326);

in view of KATOH ET AL (US 4,818,581).

PEIFFER ET AL '945 and '158 and '159 and the EP references each disclose a multilayer film comprising a matt layer and a polyester base layer and an optional additional cover layer, wherein the matt layer comprises an ethylene terephthalate and ethylene isophthalate copolyester, and wherein the base layer is typically polyethylene terephthalate, and wherein the film has the recited SPAN 98 values, planar orientation, particle amounts and sizes, optical properties, method of making, and other features. (PEIFFER ET AL '945, see entire document, especially paragraphs 0024-0031) (see corresponding portions of PEIFFER ET AL '158 and '159 and the EP references)

KATOH ET AL discloses that it is well known in the art to use copolyesters comprising ethylene terephthalate and up to 20 mol% isophthalate units in (line 49, col. 3 to line 18, col. 4) to form useful packaging films.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to use select known isophthalate-containing copolyesters in the matt layer in PEIFFER ET AL '945 and '158 and '159 and the EP references in order to optimize the film's optical and mechanical properties for specific applications.

Response to Arguments

5. Applicant's arguments filed 8/11/2005 have been fully considered but they are not persuasive.

(A) Applicant argues that the prior art fails to disclose the recited transparency value. However, as Applicant admits, the PEIFFER ET AL references clearly indicate that the films are capable of high transparency and low haze. Applicant has not provided any probative evidence to indicate that the films disclosed in the prior art are incapable of achieving transparency values of 80 or more.

(B) Applicant argues that that PEIFFER ET AL '945 fails to explicitly disclose particle diameters of 10 microns. However, as admitted by Applicant, PEIFFER ET AL '945 clearly discloses a particle size range of 2-8 microns, which clearly reads upon the claimed particle size. Applicant has not provided any probative evidence of unexpected results or criticality regarding the claimed particle diameters greater than 8 and up to 10 microns.

(C) Applicant argues that PEIFFER ET AL '945 teaches away from the claimed invention because the reference recommends the use of sulfonomers. However, the claims do not preclude the presence of other polyesters such as sulfonated copolyesters. Furthermore, the use of sulfonated copolyesters, while a preferable formulation, is not required by the references.

(D) Applicant argues that PEIFFER ET AL '945 teaches away from the claimed invention because the reference fails to explicitly disclose the recited opacity. However, the PEIFFER ET AL references clearly indicate that the films are capable of high transparency and low haze. Applicant has not provided any probative evidence to indicate that the films disclosed in the prior art are incapable of achieving the recited opacity values.

(E) Applicant argues that PEIFFER ET AL '945 teaches away from the claimed invention because the reference fails to explicitly disclose planar orientation of up to 0.170. However, the PEIFFER ET AL references clearly disclose planar orientation values of up to 0.164, which reads upon the values recited in the claims. Applicant has not provided any probative evidence of unexpected results or criticality regarding the claimed planar orientation values greater than 0.164 and up to 0.170.

(F) In response to applicant's arguments against KATOH ET AL, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). KATOH ET AL is relied on to illustrate typical amounts of isophthalate incorporated into ethylene terephthalate-ethylene isophthalate copolyesters known to be suitable for use in conventional applications such as packaging.

(G) In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). The PEIFFER references disclose substantially all features recited in the present claims, including the use of ethylene terephthalate-ethylene isophthalate copolyesters, except for the specifically recited amount of isophthalate. KATOH ET AL

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discloses typical amounts of isophthalate contained in ethylene terephthalate-ethylene isophthalate copolyesters commonly used in conventional applications such as packaging.

Applicant has not provided any probative evidence of unexpected results or criticality from the recited isophthalate content.

Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vivian Chen whose telephone number is (571) 272-1506. The examiner can normally be reached on Monday through Thursday from 8:30 AM to 6 PM. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carol Chaney, can be reached on (571) 272-1284. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

The General Information telephone number for Technology Center 1700 is (571) 272-1700.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

October 28, 2005



Vivian Chen
Primary Examiner
Art Unit 1773